

**REMARKS**

Claims 1 to 6 are presently pending in this application. Claims 1 and 6 have been amended to clarify that the structure of the retaining plates is such that when one of the unit cells or cell modules between the retaining plates is defective or deteriorated in performance, the defective or deteriorated unit cell or cell module can be removed and replaced without dismantling the entire stack. These amendments are supported throughout the specification and drawings, for example at page 10, at the end of Example 1 at page 15, at the end of example 2 at page 17, and in Fig. 3. In addition, the last clause of claim 1 has been deleted and reinserted in original claim 4, so that it appears as in the original version of this claim. Accordingly, no new matter has been added, and entry of the amendments is respectfully requested.

In the Office Action the Examiner has rejected claims 1-4 and 6 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,190,793 of Barton et al. in view of U.S. Patent No. 5,472,801 of Mattejat et al. and further in view of U.S. Patent No. 4,198,597 of Sawyer for the same reasons as set forth in the previous Office Action with respect to claim 4. In response to applicants' arguments in the Amendment and response filed August 6, 2004, the Examiner supplements his reasons for rejection in paragraphs 2-5 at pages 10-12 of the Office Action. The Examiner's principal argument in these paragraphs is that while applicants have emphasized in the prior response that the presently claimed structure allows the removal and replacement of deteriorated MEAs or unit cells, this feature of the present invention does not appear in the claims. Moreover, to the extent that this is merely an advantage of the present invention, the Examiner argues that the mere recognition of another advantage/disadvantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability if the differences would otherwise be obvious.

This rejection is respectfully but strenuously traversed for the reasons set forth in the previous response, and the additional reasons set forth below. Reconsideration and withdrawal of the rejection are respectfully requested.

First, as noted above, the two independent claims 1 and 6 have been amended to specifically claim that the structure and claimed features of the retaining plates is such that when one of the unit cells or cell modules is defective or deteriorated in performance, the defective or deteriorated unit cell or cell module can be removed and replaced without dismantling the entire

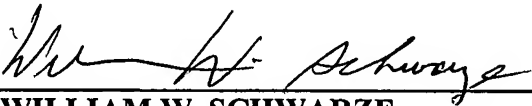
stack. This amendment should remove the Examiner's objection that the features relied upon in response to the previous Office Action were not explicitly present in the claims.

Second, with respect to the Examiner's argument that the recognition of an advantage cannot be the basis for patentability, this claimed feature is not simply an advantage but a structural requirement of the presently claimed fuel cell. Thus, although the presently claimed invention may have some features which read upon the combination of prior art proposed by the Examiner, none of the relied upon prior art, either alone or in combination, teaches or suggests that the structure allows the removal and replacement of defective or deteriorated cells without dismantling the entire fuel cell stack. Without such a teaching or suggestion, it cannot be considered obvious to combine the features of the prior art in such a way as to allow the removal and replacement of the defective or deteriorated cells without dismantling the entire stack. Therefore, the Examiner's assumption that such an advantage would flow naturally from following the suggestion of the prior art is in error and unwarranted in the present situation, and the principle of unpatentability for recognition of advantages is inapplicable.

In view of the above amendments and remarks, it is submitted that the presently claimed invention is neither taught nor suggested by the prior art, and the Examiner's objections to the claims, as set forth particularly in paragraphs 2 and 3 at pages 10-12 of the Office Action, have been overcome. Accordingly, reconsideration and an early Notice of Allowance are respectfully requested.

Respectfully submitted,

Osamu Sakai et al.

December 30, 2004 By:   
(Date) **WILLIAM W. SCHWARZE**  
Registration No. 25,918  
**AKIN GUMP STRAUSS HAUER & FELD LLP**  
One Commerce Square  
2005 Market Street, Suite 2200  
Philadelphia, PA 19103-7013  
Telephone: 215-965-1200  
**Direct Dial: 215-965-1270**  
Facsimile: 215-965-1210  
E-Mail: [wschwarze@akingump.com](mailto:wschwarze@akingump.com)

WWS/cmb

Enclosures: Request for Continued Examination (RCE)  
Petition for Extension of Time (one month)